

## REMARKS

This Response to Office Action is submitted in reply to the Office Action of April 27, 2005. Claims 1, 6, 8, 9, 14 to 16, 18, 21, 23, and 25 have been amended. Claims 5 and 13 stand cancelled without prejudice or disclaimer. No new matter has been added by these amendments.

The Office Action indicated in the Office Action Summary that James E. Kaminkow is the first named inventor. The Applicant respectfully submits, as in the October 20, 2004 Response to Office Action, that the first named inventor is Joseph E. Kaminkow.

A Supplemental Information Disclosure Statement and a Petition for a Three Month Extension of Time to file this Response are submitted herewith. A check in the amount of \$1200.00 is submitted herewith to cover the cost of the Supplemental Information Disclosure Statement and the three-month extension. Please charge deposit account number 02-1818 for any insufficiency of payment or credit for any overpayment.

The Office Action objected to Claims 6, 8, 9, 14, 15, 16, 18, and 19. Following suggestions made in the Office Action, Applicant has amended certain of the claims clarity. More specifically:

- (1) Claims 6, 8, 9, 14, and 15 have been amended to clarify that "a plurality of sets of values" is now "a plurality of sets of said values." Applicant respectfully submits that Claims 16 and 18 already reflected the phrase "a plurality of sets of said values" and needs no further clarification;
- (2) Claim 9 has been amended to clarify that "said different sets" are associated from player selected sets; and
- (3) Claim 19 has not been amended because proper antecedent basis already exists. Applicant believes that the Office Action meant to state that insufficient antecedent exists for the feature "mathematical operations." The Office Action mentioned that neither Claim 17 or 18 provides antecedent basis for "mathematical operations." However, Claim 19 depends from Claim 17, which depends from Claim 16. Claim 16 provides

proper antecedent basis for the feature "mathematical operations," thus correction is not required.

Accordingly, Applicant respectfully requests that these objections be withdrawn. These amendments have not been made to distinguish these claims over the prior art and Applicant respectfully submits that these amendments do not narrow the scope of the claims.

The Office Action rejected Claims 1 to 4, 6 to 12, and 14 to 25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 33 of U.S. Patent No. 6,599,185 to Kaminkow et al. ("Kaminkow"). The Office Action states that although the conflicting claims are not identical, at least Claim 1 of the instant application is not patentably distinct from at least Claim 28 of Kaminkow. The Office concludes that Claim 28 of Kaminkow is encompassed by Claims 1, 6, 8, 9, 14, 15, 16, 18, 21, 23 and 25 of the instant application.

Claim 28 of Kaminkow states:

[a] gaming device having a bonus round, said gaming device comprising:

a group of selections;

a plurality or pools of awards;

a display device; and

a processor operable with the display device to begin the bonus round upon a triggering event, cause one of the selections from the group of selections to be picked, determine after said selection is picked at least one award from each of a plurality of pools of awards for distribution to the selection, distribute the determined awards to the picked selection, provide a player with the awards associated with the picked selection and end the bonus round. (Emphasis added).

Amended independent Claim 1 is directed to a gaming device including a display device, a processor in communication with the display device, a plurality of selections adapted to be displayed to a player by the display device and a plurality of different values associated with the selections. The gaming device includes at least one set of a plurality of the values determined and displayed by enabling the player to pick a plurality

of the selections, wherein the plurality of values in the set are based on the values associated with the selections picked by the player. The gaming device also includes at least one award generated by the processor by selecting at least one but not all of the plurality of values of the set, wherein the award is provided to the player by the processor.

Applicant respectfully submits that Claim 28 of Kaminkow is different than and not encompassed by Claims 1 to 4, 6 to 12, and 14 to 25 of the instant application. Claim 28 of Kaminkow has a group of selections and a plurality of pools of awards, wherein a player's pick of one of the selections causes at least one award from each of the plurality of pools of awards to be distributed to the picked selection. On the other hand, in Claims 1 to 4, 6 to 12, and 14 to 25 of the present application, a player's pick of a selection is not associated with at least one award from each of a plurality of pools of awards. Claims 1 to 4, 6 to 12, and 14 to 25 include at least one set of a plurality of values determined and displayed by enabling the player to pick a plurality of selections, wherein the plurality of values in the set are based on the values associated with the player picked selections. Such claims are different than and thus not encompassed by Claim 28 of Kaminkow. At least for this reason, it is respectfully submitted that Claims 1 to 4, 6 to 12, and 14 to 25 are patentably distinguished over Kaminkow and in condition for allowance.

The Office Action rejected Claims 1, 2, 4, 8 to 10, 12, 15, and 21 under 35 U.S.C. § 102(e) as being anticipated by Frohm et al. (hereafter Frohm). Applicant respectfully disagrees with and traverses these rejections for at least the reasons discussed below.

Frohm discloses a gaming machine with a plurality of player selection elements. More specifically, Frohm discloses that:

[a]fter picks 36 are made available to the player, the lower display 14 informs the player "TOUCH GLOVES TO PUNCH OPPONENT." The CPU 20 uses a random number generator (not shown) to select a punch type for each of the displayed gloves 30 (player selectable options). In one embodiment, the punch type for each glove 30 is written over the gloves 30 as shown by the "JAB" glove 38. For convenience, this embodiment is called the options revealed embodiment. In another embodiment, a punch type or

outcome for each glove is not revealed until the player selects a glove such as the revealed "HOOK" glove 40. For convenience, this embodiment is called the options hidden embodiment. For both the options revealed and options hidden embodiments, the player selects one of the boxing gloves 30 (i.e., a player selectable option). In one embodiment, the lower display 14 includes a touch screen to allow the player to press the desired boxing glove 30.

In the options revealed embodiment, once the player selects one of the boxing gloves 36, the selected option animates on the upper display 16. For the example illustrated in FIGS. 3a and 3b, the JAB option 38 has been selected and ROCKY throws a jab punch. The CPU 20 randomly determines a punch outcome for the selected JAB option 38. The action resulting from the player's selection of an option and its outcome represent a stage of the game. Each stage of the game can result in a stage payoff dependent on the stage outcome that results from the action.

The punch outcome is a result for the thrown punch having a payoff, such as a missed punch equaling no payoff, a blocked punch equaling no payoff, a soft hit equaling 10 credits, a medium hit equaling 50 credits, a solid hit equaling 150 credits, a knock down equaling 250 credits and a knock out equaling 500 credits. For example, the JAB punch may result in the solid hit as animated on the upper display 16 in FIG. 3a with the JAB punch connecting with the face of T-Bone resulting in a 150 credit payoff to the player. Table 1 illustrates a pay table for the RINGSIDE CHAMP.TM. basic game. In the options revealed embodiment, the punches are shown to the player before the player's selection, but the outcomes of the punches are randomly determined following the player's selection.

(Column 3, line 43 to column 4, line 50) (Emphasis added). Thus, Frohm's gaming machine displays a number of selection elements to a player, the player picks from the selection elements, and the gaming machine reveals an outcome/payoff associated with the player pick. Every selection/payoff routine is considered a stage of the game that can provide a stage payoff.

Regarding amended independent Claim 1, Applicant respectfully submits that Frohm's player selection game does not disclose creating at least one set based on

values associated with the player picked selections. The Office Action states that Frohm teaches a plurality of sets of values (punch types of Figure 3B along with the related description thereof), wherein each set (punch type) includes a plurality of the values (punch outcomes) and each set is determined and displayed by enabling the player to pick a plurality of the selections. However, Frohm's discloses that a processor provides a selection field (gloves to select, Fig. 3B) and the processor randomly determines outcome/value pairs (Column 4, Table 1). The gaming machine of Frohm includes two main game features. In the first game feature, a player makes a selection and the processor randomly determines an outcome which is displayed to the player (options revealed). In the second game feature, the player makes a selection, the gaming machine displays an option, and then the processor randomly assigns an outcome/award to the option (options hidden). (Column 4, lines 30 to 49). The effect is the same from either the options hidden or options revealed sequences. The player makes a selection, then the processor provides an outcome. On the other hand, the gaming device of amended independent Claim 1 includes at least one set of a plurality of the values determined and displayed by enabling the player to pick a plurality of the selections, wherein the plurality of values in the set are based on the values associated with the player picked selections. Unlike the Office Action's assessment provided above, Frohm does not provide for any set with a plurality of values that is determined by enabling a player to pick a plurality of selections. In Frohm, a processor determines an outcome using a player's selection. The outcome is an award and is not equivalent to a plurality of values that make a set. The Office Action states that Frohm has sets, but Frohm makes no express or inherent disclosure that a gaming machine includes at least one set of a plurality of the values determined and displayed by enabling the player to pick a plurality of the selections, wherein the plurality of values in the set are based on the values associated with the player picked selections.

Additionally, if the gaming machine in Frohm does not disclose creating at least one set of values based on the values associated with the player picked selections, then the gaming machine also does not and can not include at least one award generated by the processor by selecting at least one but not all of the plurality of values of the set.

On the other hand, the gaming device of amended independent Claim 1 further includes at least one award generated by the processor by selecting at least one but not all of the plurality of values of the set. Thus, in addition to associating a plurality of different values with selections and determining and displaying a set of a plurality of values based on the player's picks of the selections, the gaming device of amended independent Claim 1 includes generating at least one award by selecting at least one but not all of the plurality of values in the set. In Frohm, each player selection provides a single outcome and does not become part of a plurality of outcomes in a set. Thus, Frohm does not and could not disclose a processor generating at least one award based on selecting at least one but not all of the values in the determined set. For these reasons, it is respectfully submitted that amended independent Claim 1 is patentably distinguished over Frohm and in condition for allowance.

Claims 2 to 4 depend directly or indirectly from Claim 1 and are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

Independent Claims 6, 8, 9, 14, 15, 16, 18, 21, 23, and 25 have each been amended to clarify that a gaming device includes, amongst other elements, a plurality of sets of the values, wherein each set includes a plurality of the values and each of the sets is determined and displayed by enabling the player to pick a plurality of the selections, wherein the plurality of values in the sets are based on the values associated with the selections picked by the player. As described above with respect to Frohm, a player's selection produces an outcome. However, a player's selection in Frohm does not create a set with a plurality of values, or a set with a plurality of values associated with selections picked by the player. For this reason and the reasons given with respect to independent Claim 1, Applicant respectfully submits that amended independent Claims 6, 8, 9, 14, 15, 16, 18, 21, 23, and 25 are patentably distinguished over Frohm and in condition for allowance.

Claims 7, 10 to 12, 17, 19, 20, 22, and 24 depend directly and indirectly from amended independent Claims 6, 8, 9, 14, 15, 16, 18, 21, 23, and 25, respectively, and are allowable for the reasons given with respect to these independent claims.

Accordingly, Applicant respectfully submits that Claims 7, 10 to 12, 17, 19, 20, 22, and 24 are in condition for allowance.

The Office Action rejected Claims 3, 6, 7, 11, 14, 16 to 20, and 22 to 25 under 35 U.S.C. § 103(a) as being unpatentable over Frohm in combination with Vancura.

As described above, Frohm relates to a gaming machine with multiple player selections, where each player pick produces an outcome/award. As stated in the Office Action, Vancura relates to a gaming device that discloses using mathematical modifiers as awards in a bonus game, wherein the game operators can vary the odds affecting game payouts using the modifiers.

The Office Action states that Frohm does not explicitly teach generation of an award (e.g., a plurality of awards or a resulting award) that is provided to the player by performing at least one mathematical operation on the awards from the sets. The Office Action further states that it would have been obvious for one skilled in the art to perform mathematical operations selected from the group consisting of addition, subtraction, multiplication or division in a bonus game as taught by Vancura to modify the awards provided to a player in the gaming device taught by Frohm et al. to increase the player excitement and lengthen the game as desirably taught by Vancura. Applicant respectfully submits that regardless of whether it would have been obvious to incorporate mathematical operations into Frohm, neither Frohm nor Vancura individually, nor the gaming device resulting from the combination of Frohm and Vancura include at least a plurality of sets of values, wherein each set includes a plurality of values and each set is determined and displayed by enabling the player to pick a plurality of the selections, wherein the plurality of values in the sets are based on the values associated with the selections picked by the player. On the other hand, the gaming devices of Claims 3, 6, 7, 11, 14, 16 to 20, and 22 to 25 each include, amongst other elements, at least a plurality of sets of values, wherein each set includes a plurality of values and each set is determined and displayed by enabling the player to pick a plurality of the selections, wherein the plurality of values in the sets are based on the values associated with the selections picked by the player. Accordingly, for this reason and the reasons given with respect to the amended independent claims,

Applicant respectfully submits that Claims 3, 6, 7, 11, 14, 16 to 20, and 22 to 25 are patentably distinguished over Frohm in combination with Vancura and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art, such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY   
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Dated: October 20, 2005